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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057122
Party	Plaintiff Neways, Inc.
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Attachments	Neways Answer to Counterclaim.pdf(161959 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 3,448,249

Mark: **NEW-WHEY**

Registered: June 17, 2008

-and-

Trademark Registration No. 4,214,663

For the Mark: **NEW WHEY NUTRITION**

Registered: September 25, 2012

-and-

Trademark Registration No. 4,172,454



For the Mark: **New Whey**
Nutrition

Registered: July 10, 2012

NEWAYS, INC.,

Petitioner,

v.

NEW WHEY NUTRITION, LLC, f/k/a
TOPSPIN-IDS ACQUISITION, LLC

Registrant.

Cancellation No. 92057122

**PETITIONER NEWAYS, INC.'S
ANSWER TO REGISTRANT
NEW WHEY NUTRITION,
LLC'S COUNTERCLAIM FOR
PARTIAL CANCELLATION OF
NEWAYS' REGISTRATIONS**

In response to the Counterclaim for Partial Cancellation Of Neways' Registrations filed by registrant New Whey Nutrition, LLC, f/k/a Topspin-IDS Acquisition, LLC. ("Registrant") in New Whey Nutrition, LLC's Answer, Affirmative Defenses, and Counterclaims to

Petitioner Newways, Inc.'s Petition to Cancel, dated June 12, 2013 ("the Counterclaim"), Petitioner and Counterclaim Defendant Newways, Inc. ("Newways") answers as follows:

Newways denies that Registrant is or will be damaged by the Newways' Registrations as alleged in the first unnumbered paragraph of the Counterclaim. To the extent that the remaining allegations of the first unnumbered paragraph of the Counterclaim constitute allegations of fact to which a response is required, Newways hereby denies the same.

1. Newways is without knowledge or information sufficient to form a belief as to the truth of the matters asserted paragraph 1 of the Counterclaim, and therefore denies same.

2. Newways is without knowledge or information sufficient to form a belief as to the truth of the matters asserted paragraph 2 of the Counterclaim, and therefore denies same.

3. Newways is without knowledge or information sufficient to form a belief as to the truth of the matters asserted paragraph 3 of the Counterclaim, and therefore denies same.

4. Newways admits that a review of the Trademark Electronic Search System ("TESS") database of the United States Patent and Trademark Office ("PTO") shows that the application that eventually matured into U.S. Trademark Registration No. 3448249 for the mark "NEW-WHEY" for goods listed as "nutritionally fortified beverages containing whey protein" in international class 005 was filed by Supplement Synergy, Inc. on August 14, 2007 and was registered on June 17, 2008 ("the '249 Registration"). Newways further admits that the '249 Registration claims a date of first use at least as early as February 28, 2006 and a date of first use in commerce at least as early as March 31, 2006. Newways specifically denies the allegation set forth in paragraph 4 of the Counterclaim that the '249 Registration was filed "[i]n 2006", that the '249 Registration was filed by New Whey Nutrition, and that the '249 Registration "matured ... on August 14, 2007[.]" Newways further admits that Topspin-IDS

Acquisition, LLC (which later changed its name to New Whey Nutrition, LLC) is the listed applicant of the trademark application that matured into U.S. Trademark Registration No. 4214336 for the mark NEW WHEY NUTRITION for goods listed as “nutritional supplement containing whey protein” in international class 005 (“the ’336 Registration”). Neways further admits that Topspin-IDS Acquisition, LLC is the listed applicant of the trademark application that matured into U.S. Trademark Registration No. 4172454 for the mark NEW WHEY NUTRITION (plus design) for goods listed as “nutritional supplements containing whey protein” in international class 005 (“the ’454 Registration”). Neways denies all remaining allegations of paragraph 4 of the Counterclaim.

5. Neways admits that a review of the Trademark Status & Document Retrieval database of the PTO shows that the database does not identify an instance where any of Neways’ trademark registrations were cited against the New Whey Nutrition Registrations. Neways further admits that Neways did not oppose the applications that matured into the New Whey Nutrition Registrations, nor did Neways contact New Whey Nutrition to object to the applications before they were registered. Neways denies all remaining allegations of paragraph 5 of the Counterclaim.

6. Neways admits that on November 11, 2010, Topspin-IDS Acquisition, LLC filed with the PTO an application for registration of the mark NEW WHEY for goods listed as “nutritionally fortified beverages containing whey protein” in international class 005, which was assigned Trademark Application Serial No. 85174256 (“the ’256 Application”). Neways further admits that a review of the Trademark Status and Document Retrieval database of the PTO shows that the examiner did not cite any of Neways’ registrations against the ’256

Application, and that the '256 Application was eventually published for opposition. Neways denies all remaining allegations of paragraph 6 of the Counterclaim.

7. Neways admits that it filed an opposition against the '256 Application on August 17, 2011, which was assigned Opposition No. 91201238 by the Trademark Trial and Appeal Board and which is currently pending. Neways further admits that as of August 17, 2011, it had not petitioned to cancel any of the trademark registrations owned by New Whey Nutrition. Neways denies all remaining allegations of paragraph 7 of the Counterclaim.

8. Neways admits that it is a privately held enterprise, and that it manufactures and distributes an extensive line of quality, safety-conscious personal care products, household products, and nutritional supplements. Neways further admits that it sells nutritional supplements under the NEWAYS mark that include Cleansing Tea, Feelin Good, and Digestamin products, among others. Neways further admits that it sells personal care products and household products identified on its website, also under its NEWAYS mark. The Wikipedia web page and the Neways web site referred to in paragraph 8 speak for themselves. Neways denies all remaining allegations of paragraph 8 of the Counterclaim.

9. Neways admits that what purports to be a copy of the Wikipedia web page referenced in paragraph 9 is attached to the Counterclaim as Exhibit B. The referenced web page speaks for itself. Neways denies all remaining allegations of paragraph 9 of the Counterclaim.

10. Neways admits that it does not distribute its products on Amazon.com. Neways further admits that retail customers that go directly to Neways website, as opposed to accessing Neways website from a distributor website, are required to identify a referring distributor to access and make purchases from the website, and that the referring distributor receives credit

for referred retail customer purchases. The referred-to exhibits speak for themselves.] Neways denies all remaining allegations of paragraph 10 of the Counterclaim.

11. Neways admits that it has used its NEWAYS marks on its products since at least as early as 1992. Neways is without information and belief as to when New Whey Nutrition began using its NEW WHEY marks, and therefore denies the remaining allegations of paragraph 11 of the Counterclaim.

12. Neways admits paragraph 12 of the Counterclaim sets forth a listing of registrations owned by Neways and identified in the Petition for Cancellation filed by Neways in the above-captioned action. The registrations speak for themselves. Neways further admits that Registration Nos. 2656486 and 2656490 were cancelled by the PTO. Neways denies any remaining allegations of paragraph 12 of the Counterclaim.

13. The Petition for Cancellation speaks for itself. Neways denies all other allegations of paragraph 13 of the Counterclaim.

14. Neways denies the allegations of paragraph 14 of the Counterclaim.

15. Neways denies the allegations of paragraph 15 of the Counterclaim.

Any allegation of the Counterclaim not specifically admitted is denied.

AFFIRMATIVE DEFENSES

Without admitting or acknowledging that it bears the burden of proof as to any of the defenses set forth herein, Neways alleges the following as affirmative or additional defenses to the Counterclaim:

FIRST AFFIRMATIVE DEFENSE

Registrant's Counterclaim fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Registrant is not likely to be damaged by any of Neways' trademark registrations and, therefore, lack standing to partially cancel Neways' trademark registrations.

Neways reserves the right to amend or supplement its answers and defenses as more information becomes available during discovery in this matter.

RELIEF REQUESTED

In view of the foregoing, Neways respectfully requests that the relief requested by Registrant be denied, that the Counterclaim be dismissed with prejudice, and that the registration of United States Registration Nos. Registration Nos. 2471380, 2389764, 2731042, 2492629, 279001, 3006252, 3850494, 3709468, 3703119, 2454358, 2414219, 2779438, 2943333, 2984458 be upheld.

DATED this 2nd day of August, 2013.

Respectfully submitted,

/Matthew A. Barlow/

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ATTORNEYS FOR PETITIONER
NEWAYS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITIONER NEWAYS, INC.'S ANSWER TO REGISTRANT NEW WHEY NUTRITION, LLC'S COUNTERCLAIM FOR PARTIAL CANCELLATION OF NEWAYS' REGISTRATIONS** was served upon Applicant via U.S. Mail and is addressed to the counsel of record for Applicant:

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Dated this 2nd day of August, 2013.

/Matthew A. Barlow/

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